

### **REMARKS**

Reconsideration is respectfully requested in view of the amendments and remarks herein.

#### **Information Disclosure Statement**

In paragraph 2 of the Action, the Action states that the Information Disclosure Statement filed 12 December 2003 fails to comply with 37 CFR 1.98(a)(2) since copies of JP 56-200227 and Korea 1996-067992 were not submitted and are not in the parent application file wrapper. The application numbers, rather than the publication numbers, were listed in the original forms. An Information Disclosure Statement is submitted herewith citing the correct publication numbers. New copies of the documents are included.

#### **Specification**

In paragraph 3 of the Action, the abstract is objected to because of the use of the phrase “are disclosed.” The Abstract has been revised as requested.

In paragraph 5, the Action states that the status of the parent applications should be updated. The status has been updated.

In paragraph 6, the Action states that the title should be more descriptive. The suggested title has been inserted.

#### **Claim Objections**

Claim 1 is objected to because of the misspelling of “terephthalate.” This error has been corrected.

#### **Double Patenting**

Claims 1, 2 and 21-33 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 6,685,859B2 Howell et al (“Howell”).

The Action states that although the conflicting claims are not identical, they are not patentably distinct from each other. The Action states that the instant claims encompass non-round filaments such as claimed in Howell, and that making non-round filaments using the claimed invention would have been obvious to the person of ordinary skill in the art.

Applicants traverse this rejection for the reason that the claims should not be rejected over Howell under the judicially created doctrine of obviousness-type double patenting because the claims of the instant application and Howell are directed to substantially different subject matter and a rejection based upon this ground is unjustified.

MPEP804 II. B. contains a detailed discussion of the judicially created doctrine of obviousness-type double patenting. MPEP II. B. explains that the judicially created doctrine of obviousness-type double patenting is based upon the public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. It states:

“A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).”

MPEP804 II. B. 1. focuses on obviousness-type double patenting. It explains that the first test is whether any claim in the application define an invention that is merely an obvious variation of an invention claimed in the cited patent. It explains that an obviousness-type double patenting rejection is appropriate when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. According to the MPEP, the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, so that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis.

The MPEP states:

“In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

“A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

“Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. ...”

The invention of the subject application is significantly different from the invention of Howell, and therefore an obviousness-type double patenting rejection is inappropriate. The reason is that the claimed invention concerns preparing partially oriented yarns that are useful in preparation of textured polyester multifilament yarns, particularly in friction false-twisting of partially oriented yarns, whereas Howell is directed to preparing direct use yarns.

The claimed invention concerns preparing partially oriented yarns that are useful in preparation of textured polyester multifilament yarns, particularly in friction false-twisting of partially oriented yarns. Thus, the claims are focused on a process for spinning a stable partially oriented yarn, comprising extruding a polyester polymer through a spinneret at a spinning speed less than 2600 mpm and a temperature between about 250°C and 270°C, wherein said polymer comprises at least 85 mole % poly(trimethylene terephthalate) wherein at least 85 mole % of repeating units consist of trimethylene units, wherein said polymer has an intrinsic viscosity of at least 0.70 dL/g, and wherein said stable partially oriented yarn has an elongation to break of from 110 to 137.1 %.

In contrast, Howell is directed to a process for spinning a direct-use yarn. The process comprises extruding a polyester polymer through a spinneret to form molten streams of polymer at a spinning speed less than 4500 mpm and a temperature between about 255°C and about 275°C, solidifying the molten streams to form non-round filaments, and converging said filaments to form said yarn.. The polymer comprises at least 85 mole % poly(trimethylene terephthalate) wherein at least 85 mole % of repeating units consist of trimethylene units, and has an intrinsic viscosity of at least 0.70 dl/g.

The differences between the partially oriented yarns prepared according to the invention and the direct-use yarns prepared by Howell are well known in the art. For instance, it is well known that partially-oriented yarns are drawn or draw-textured before use in fabrics, whereas the "direct-use" spun yarns of Howell can be used to make textile products without further drawing. (See, e.g., Howell, column 1, lines 39-51.) That is, the process of the invention partially orients the yarns and the yarns are then further drawn or draw-textured in a subsequent step before use in fabrics. In contrast, the direct-use yarns prepared by Howell is fully oriented and is not drawn or textured in a separate processing step. (See, e.g., Howell, column 3, lines 40-44; column 2, lines 66-67, etc.)

For the above reasons, it can be seen that the claimed invention is not an obvious variation of the invention claimed in Howell, and a second independent patent is justified since the resulting patent would not be an extension of the term of the right to exclude granted by Howell. Consequently, withdrawal of the rejection of the claims under the judicially created doctrine of obviousness-type double patenting over the claims of Howell is respectfully requested.

Other Amendments

The subject matter of claim 33 is inserted into claim 1 and the claims reciting 110% elongation were cancelled. Entry and consideration are respectfully requested.

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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